

In re of Appln. No. 10/009,167
Reply dated: April 27, 2005
In Reply to OA dated: March 29, 2005

REMARKS

The Official Action of March 29, 2005, entirely in the nature of a requirement for restriction based on alleged lack of unity-of-invention, has been carefully reviewed. The claims in the application are now claims 1 and 5-19, and applicants believe and respectfully submit that unity-of-invention exists and that the claims define novel and unobvious subject matter, whereby the requirement should be withdrawn and all the claims should be allowed. Favorable reconsideration and allowance are respectfully requested.

The present application is the U.S. national phase of PCT/IL00/00333 filed June 7, 2000, and claims priority from application 130326 filed in Israel on June 7, 1999. The 371 formalities letter received by applicants from the PTO, mailed February 5, 2002, indicates that the PTO has received the priority document. **Accordingly, applicants respectfully request the examiner to acknowledge receipt of applicants' papers filed under §119.**

Restriction has been required between what the PTO deems to be two (2) patentably distinct inventions. As applicants must make an election even though the requirement is traversed, applicants hereby respectfully and provisionally

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elect Group I, presently claims 1 and 5-16, with traverse and without prejudice.

The PTO correctly recognizes that normal restriction practice does not apply, as the present application is the U.S. national phase of a PCT (international) application, wherein PCT Rules 13.1 and 13.2 apply rather than normal restriction practice. But the Office Action is wrong when it incorrectly states that the claims of the two groups "lack the same or corresponding special technical feature [because the claims] are unified only by the semiconductor device of Group I, which is well known in the art" as disclosed by Heller USP 5,632,957.

Rhus, contrary to what is stated in the Office Action, Heller does not either disclose or make obvious the elected semiconductor device of Group I. To bring out more clearly that the two groups share the same general inventive concept, claim 1 has been reformulated by incorporation of the definition of method claim 17. This amendment further stresses the unexpected result obtained by the present invention, making more explicit the effect of the DNA on the electronic properties of the substrate. The change in the DNA configuration from a single-stranded DNA to a double-stranded DNA, after hybridization to a target DNA or RNA, results in a change in the signal in the semiconductor device, and this

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feature, which exists in both groups and is therefore "the same or corresponding special technical feature", is both novel and non-obvious over Heller and any other known prior art.

Accordingly, the restriction requirement should be withdrawn on this basis alone, and such is respectfully requested.

Applicants believe that all issues raised in the Office Action have been addressed above, in favor of withdrawal of the restriction requirement. Applicants respectfully request such withdrawal of the restriction requirement, and examination on the merits of all the presently pending claims. Applicants now respectfully await the results of an examination on the merits.

Respectfully submitted,

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